

REMARKS

Claim 1 has been amended to incorporate the requirement of claim 9. Claims 7 and 9 have been amended to incorporate the list of Lewis acids found in claims 13 and 14, respectively.

New claims 20-23 have been added. Claims 20-23 incorporate the acylating agents of claim 6 into claims 5, 12, 14 and 16, respectively. Additionally, claims 20 and 23 incorporate the Lewis acids of claim 7 into claims 5 and 16, respectively.

Rejection under 35 U.S.C. §112 first paragraph

Reconsideration is requested of the rejection of claims 1-19 under 35 U.S.C. §112 first paragraph for failing to comply with the written description requirement.

According to the Office, the terms "hydrocarbyl," "substituted hydrocarbyl," "heteroaryl" and "protecting group" do not convey to one of ordinary skill that applicants were in possession of the claimed subject matter. This assertion is traversed. These terms are well known to persons of ordinary skill and are defined at pages 34-37 of applicants' specification, in any event.

The Office has asserted that claims "employing functional language at the point of novelty, such as applicants', neither provide those elements require to practice the inventions, nor 'inform the public' during the life of the patent of the limits of the monopoly asserted."¹ This assertion misses the mark. These terms do not even appear in claims 1, 3, 6-10, 13 and 14-19 and do not define the point of novelty in any event. Claim 1 is directed to a process in which the C(10) hydroxy group of a taxane having C(7) and C(10) hydroxy groups is selectively acylated. The novelty of this process does not depend, for example, upon whether X₁₀ is hydrocarbyl, substituted hydrocarbyl or heteroaryl as defined by claim 4, or otherwise. In view of applicants' specification and examples, a person of ordinary skill would readily understand

¹ March 6, 2006 Office action at page 3.

applicants to be in possession of a process for selectively acylating the C(10) hydroxy group of a taxane having C(7) and C(10) hydroxy groups regardless of the scope of the terms "hydrocarbyl," "substituted hydrocarbyl," "heteroaryl" and "protecting group".

Rejection under 35 U.S.C. §103(a)

Reconsideration is requested of the rejection of claims 1 and 3-19 under 35 U.S.C. §103(a) as being unpatentable over Sisti, US Patent No. 5,750,736.

Sisti is directed to selective acylation of the C(10) hydroxide of 10-DAB over the C(7) hydroxide. Specifically, Sisti discloses a method of selective acylation at C(10) of 10-DAB III with the steps of (a) dissolving 10-DAB III in a solvent, (b) mixing at least one equivalent of a lithium base into the solution, (c) adding at least one equivalent of an acylating agent to the solution, and (d) quenching the final solution with a compound effective enough to eliminate the excess lithium base and acylating agent. Sisti's process, therefore, requires activation of the C(10) position with a lithium base such as n-BuLi to form a C(10) lithium alkoxide before addition of an acylating agent such as acetyl chloride or acetyl anhydride (see Sisti, column 5, lines 32-48).

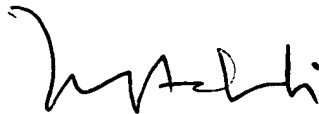
Claim 1 is directed to a process for the selective acylation of the C(10) hydroxide of 7,10-dihydroxytaxanes with various acylating agents in the presence of a Lewis acid. Sisti fails to disclose or suggest this process.

Claims 3-19 depend from claim 1 and introduce further requirements to the process of claim 1. Sisti fails to disclose or suggest the processes defined by these claims.

CONCLUSION

In view of the foregoing, favorable consideration and allowance of claims 1 and 3-23 is requested. The Examiner is invited to contact the undersigned should any issue remain unresolved. The Commissioner is hereby authorized to charge to Deposit Account No. 19-1345 any fees under CFR 1.16 and 1.17 which may be required during the pendency of this application.

Respectfully submitted,



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